



PATENT
Customer Number: 22,852
Attorney Docket No. 04853.0079-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Kazunari TAIRA et al.) Group Art Unit: 1652
)
Application No.: 09/974,974) Examiner: Charles L. Patterson, Jr.
)
Filed: October 12, 2001)
)
For: NUCLEIC ACID ENZYMES)
ACQUIRING AN ACTIVITY)
FOR CLEAVING A TARGET)
RNA BY RECOGNIZING)
ANOTHER MOLECULE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants now respond to the Office Action mailed February 5, 2004. A Petition for a Two Month Extension of Time and the requisite fee are filed herewith.

The Examiner required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I: claims 1-19 and 24-30, allegedly drawn to a nucleic acid enzyme, a pharmaceutical composition comprising the enzyme, a method of cleaving RNA using the enzyme, a host cell comprising the enzyme, and a diagnostic agent comprising the enzyme.

Group II: claims 20-21 and 24-26, allegedly drawn to an expression vector comprising DNA encoding the nucleic acid enzyme, a method of making the enzyme by using the vector, and a pharmaceutical composition comprising the vector.

Group III: claims 22-26, allegedly drawn to a gene transfer vehicle comprising the nucleic acid enzyme, and a pharmaceutical composition comprising the transfer vehicle.

Office Action at page 2. The Examiner noted that claims 24-26 are included in all three groups. *Id.*

The Examiner further requested clarification of the claims of Group III. Office Action at page 3. Specifically, the Examiner pointed out that the claims of Group III are “drawn to a ‘gene transfer vehicle comprising the nucleic acid enzyme’ but an enzyme is not a gene.” *Id.* The Examiner noted that clarification might result in Group III being combined with either Group I or Group II. *Id.*

With respect to the Examiner’s request for clarification of the claims of Group III, Applicants point out that the nucleic acid enzyme of claim 1 is a nucleic acid that acts as an enzyme. See specification, e.g., at Figure 3B, which shows a particular embodiment of an HIV-1 trans-maxizyme comprising SEQ ID NOs:1 and 2, and at page 13, which provides a description of Figure 3B. Therefore, the gene transfer vehicle of claims 22 and 23, in comprising the nucleic acid enzyme of claim 1, comprises a nucleic acid. The term “gene transfer vehicle” in the preamble is non-limiting, and one skilled in the art could use a gene transfer vehicle to transfer a nucleic acid other than a gene.

Applicants elect Group I, claims 1-19 and 24-30, with traverse. As discussed above, the gene transfer vehicle of claims 22 and 23 (Group III) comprises the nucleic acid enzyme of claim 1 (Group I). Therefore, the examination of the claims in Group III along with those of Group I would not pose a serious burden. See MPEP § 803 at 800-4 (8th ed., rev. 1).

Additionally, Applicants point out that claims 20 and 21 (Group II) encompass “an expression vector comprising DNA encoding the nucleic acid enzyme according to claim

1." Because the DNA encompassed by claims 20 and 21 and the nucleic acid enzyme of claim 1 are both nucleic acids, and because these nucleic acids are closely related to one another by virtue of the fact that the former encodes the latter, Applicants respectfully submit that examination of the claims in Group II along with those of Group I would not pose a serious burden. Therefore, Applicants respectfully request examination of all three groups.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 15, 2004

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